

REMARKS

This application has been reviewed in light of the Office Action dated July 23, 2004. Claims 1-40 are pending in the application. Claims 10 and 15-32 are withdrawn. Claims 1, 33 and 38 are amended in a manner that Applicants believe overcome the rejections in the Office Action. Support for the amendments can be found throughout the specification and figures of the present disclosure and recite aspects that Applicants are believed to be entitled. Applicants submit that no new matter or issues are introduced by the amendments.

Initially, the Examiner indicates that the priority claim in the present application may be accepted if accompanied by a grantable petition to accept an unintentionally delayed priority claim under 37 CFR 1.78 (a)(3). Applicants are enclosing a courtesy copy of such petition under 37 CFR 1.78 (a)(3) which has been filed concurrently herewith.

In the Office Action, claims 1-6, 9 and 10-14 were rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,823,997 to Thorne (Thorne '997). However, it is respectfully submitted that amended independent claim 1, claims 2-6 and 9-14 depending therefrom (although claim 10 is withdrawn from consideration), clearly and patentably distinguish over the Thorne '997 patent.

Referring to FIGURES 9 and 10, the Thorne '997 patent discloses a shroud 140 having a distal part 170. (col. 7, lines 39-47). Part 170 is rotated such that a superior face 206, located at the free distal end of part 170, is distally disposed relative to a needle tip 44. (col. 8, lines 8-10 and 20-23). Superior face 206 does not slidably engage needle 40 and is separate and apart from a ledge member 186 (see FIGURE 7 in cross section). In contrast, amended claim 1 of the present application recites "[a] safety shield apparatus comprising: a needle having a distal portion and a proximal portion; and a shield including at least one elongated part, the shield having a proximal end mounted with the proximal portion of the needle and a distal end mounted with a planar contact surface, the planar contact surface including a needle linear bearing that slidably engages the needle to facilitate movement of the needle relative to the shield, the shield being extensible between a retracted position and an extended position via fixed positioning of the planar contact surface relative to movement of the shield."

The Thorne '997 patent in no way discloses or suggests structure as recited in amended claim 1. The Thorne '997 patent does not disclose, *inter alia*, a safety shield having a distal end mounted with a planar contact surface, the planar contact surface including a needle linear bearing that slidably engages the needle to facilitate movement of the needle relative to the shield, the shield being extensible between a retracted position and an extended position via fixed positioning of the planar contact surface relative to movement of the shield. Rather, the Thorne '997 patent shows a free distal face that does not slidably engage the needle to facilitate movement of the needle. One of the advantages of Applicant's claimed configuration is the prevention of undesired rebound or jerking motion during extension of the shield.

Because of the above distinctions, it is respectfully submitted that amended independent claim 1, claims 2-6 and 9-14 depending therefrom are patentable and not obvious over the Thorne '997 patent. Reconsideration and withdrawal of the rejection is respectfully requested.

In the Office Action, claims 1-3, 5-9, 11-14 and 33-40 were rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 5,997,504 to Bell (Bell '504). However, it is respectfully submitted that amended independent claim 1, claims 2, 3, 5-9, 11-14 depending therefrom, amended independent claim 33, claims 34-37 depending therefrom, amended independent claim 38 and claims 39-40 depending therefrom, clearly and patentably distinguish over the Bell '504 patent.

Referring to FIGS. 4A, 11 and 12A-12C, the Bell '504 patent discloses an assembly base 120, coupled to a needle assembly 104, such that a needle 16 extends through an open space defined by an aperture rim 131. (col. 12, lines 34-40). Aperture rim 131 does not engage needle 16. In contrast, amended claim 1 of the present application is recited above. Amended claim 33 of the present application recites, *inter alia*, "[a] safety shield comprising...a shield including... a distal end mounted with a planar contact surface, the planar contact surface including a needle linear bearing that slidably engages the needle to facilitate movement of the needle relative to the shield, the shield being extensible between a retracted position and an extended position via fixed positioning of the planar contact surface relative to movement of the shield." Amended claim 38 recites, *inter alia*, "[a] safety shield comprising... a shield means... having a planar body contacting surface, the planar body contacting surface including a needle linear bearing that

slidably engages the needle to facilitate movement of the needle relative to the shield via fixed positioning of the planar contact surface relative to movement of the shield.”

The Bell `504 patent in no way discloses or suggests structure as recited in amended claims 1, 33 and 38. The Bell `504 patent does not disclose, *inter alia*, a safety shield having a distal end mounted with a planar contact surface, the planar contact surface including a needle linear bearing that slidably engages the needle to facilitate movement of the needle relative to the shield, the shield being extensible between a retracted position and an extended position via fixed positioning of the planar contact surface relative to movement of the shield. Rather, the Bell `504 patent shows a base rim that defines an open space adjacent to the needle; the base rim does not engage the needle to facilitate slidable movement of the needle.

Because of the above distinctions, it is respectfully submitted that amended independent claim 1, claims 2, 3, 5-9, 11-14 depending therefrom, amended independent claim 33, claims 34-37 depending therefrom, amended independent claim 38 and claims 39-40 depending therefrom are patentable and not obvious over the Bell `504 patent. Reconsideration and withdrawal of the rejections are respectfully requested.

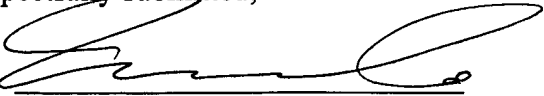
In view of the foregoing amendments and remarks, it is respectfully submitted that claims 1-9, 11-14 and 33-40 presently pending in the application are believed to be in condition for allowance and patentably distinguish over the art of record. An early notice thereof is earnestly solicited.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call the Applicants' undersigned attorney.

Please charge any deficiency as well as any other fee(s) which may become due at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 50-0369. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 50-0369 therefor.

Respectfully submitted,

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